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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,536	10/16/2003	Damian Franken Manning	12804/100001	5974

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EXAMINER

CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/685,536	Applicant(s) MANNING ET AL.	
	Examiner David G. Cervetti	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

DETAILED ACTION

1. Applicant's arguments filed June 16, 2006, have been fully considered but they are not persuasive.
2. Claims 1-65 are pending and have been examined.

Response to Amendment

3. The objection to the undefined terms and to the hyperlinks *is not* withdrawn. Applicant argues *that the information pointed to by such hyperlinks is necessary for a full understanding of the invention*, Applicant is, therefore, *required* to provide the information in the form of an Information Disclosure Statement with appropriate printed copies.
4. The objection to the drawings *is not* withdrawn.
5. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.
6. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.
7. The following prior art has been cited:
 - Tadayon et al. (US Patent Application Publication 2002/0184156, hereinafter "Tadayon"),

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- Brody (US Patent Application Publication 2001/0051928),
- Collins, III et al. (US Patent Number 6,138,153, hereinafter "Collins"),
- Stefik et al. (US Patent Number 6,920,436, hereinafter "Stefik"), and
- Sato et al. (US Patent Application Publication 2003/0041123, hereinafter Sato).

8. Tadayon teaches using a plurality of rights management associated with the content, such as copy control policies, etc. and performing a plurality of checks on the receiving device, transfer permission. Examiner respectfully submits that these features of Tadayon anticipate the newly added claim limitations of the invention. Furthermore, Sato teaches transferring the file only to the specific type of memory if the transfer software is installed (paragraphs 62-65).

9. *The applicant has not traversed the examiner's use of official notice with regards to the claimed limitations found in claims 2-3, 21-22, and 40-41, these features are taken by the examiner to be admitted prior art since the applicant has not adequately challenged the examiner's use of official notice (see MPEP 2144.03(c), 2144.04).*

Information Disclosure Statement

10. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on

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form PTO-892, they have not been considered. Applicant is required to provide the references.

Drawings

11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 119 (page 3, perhaps 113 was intended), 302 (page 13). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

12. The disclosure is objected to because of the following informalities: "CD-ROM" (page 2), "DVD" (page 3), "CD-RW" (page 7), "CD-R/RW" (page 9), "USB", "PCI", "SCSI" (page 14). These terms have not been defined. Appropriate correction is required.

13. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (pages 4, 7, 8, and 10). Applicant is required to

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delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 103

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadayon, and further in view of Brody, Collins, and Sato.

Regarding claims 1, 20, and 39, Tadayon teaches

- receiving sending instructions to transfer to a recipient a file, said sending instructions identifying a specific type of memory device on which the file is permitted to be stored at the recipient (paragraphs 17-30);
- receiving the file (paragraphs 17-30);
- receiving a request for the file from the recipient (paragraphs 17-30);
- sending the file to the recipient to be stored on the specific type of memory device (paragraphs 17-30).

Tadayon does not expressly disclose sending a notice to the recipient or determining if certain software is installed. However, Brody teaches sending a notice to the recipient indicating that the recipient may download the file (paragraphs 186-191) and Collins teaches determining if transfer software is installed at the recipient; if transfer software is not installed at the recipient, then sending the transfer software to the recipient (column 5, lines 1-67, column 6, lines 1-67), and Sato teaches recording

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only to a specific type of memory if the software is installed (paragraphs 62-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send a notice to a recipient indicating download information, to determine if needed software is installed on recipient's device, and to transfer the file to a specific type of memory device with the digital rights management system of Tadayon. One of ordinary skill in the art would have been motivated to do so because it was well known in the art to provide email notifications to users (Brody, paragraphs 186-191), because it was well known to provide customer support by determining the installed software and to push updates of software and/or software needed to access a requested resource (Collins, column 1, lines 1-67), and to provide stronger digital rights management, and provide content as packaged media (Sato, Summary of the Invention).

Regarding claims 12, 31, 50, and 58, Tadayon teaches

- receiving at least one criterion that a memory device at a recipient must have to store information to be sent from a sender, the at least one criterion being a type of the memory device (paragraphs 17-30);
- receiving a digital rights management control associated with the information (paragraphs 17-30);
- receiving a request for the information from the recipient (paragraphs 17-30);
- sending the file to the recipient to be stored on the memory device (paragraphs 17-30).

Tadayon does not expressly disclose sending a notice to the recipient or determining if a device has a criterion. However, Brody teaches sending a notice to the recipient indicating that the recipient may download the file (paragraphs 186-191) and Collins teaches determining if a criteria is at a receiver (column 5, lines 1-67, column 6, lines 1-67), and Sato teaches sending only if a memory device has a criteria (paragraphs 62-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send a notice to a recipient indicating download information, to determine if needed software is installed on recipient's device, and to transfer the file to a specific type of memory device with the digital rights management system of Tadayon. One of ordinary skill in the art would have been motivated to do so because it was well known in the art to provide email notifications to users (Brody, paragraphs 186-191), because it was well known to provide customer support by determining the installed software and to push updates of software and/or software needed to access a requested resource (Collins, column 1, lines 1-67), and to provide stronger digital rights management, and provide content as packaged media (Sato, Summary of the Invention).

Regarding claims 2-3, 21-22, and 40-41, the combination of Tadayon, Brody, Collins, and Sato teaches wherein the sending instructions identify the specific type of memory device to be a CD-ROM / flash memory (Sato, paragraphs 58-70) and these features have been admitted per applicant to have been conventional and well known to digital rights management systems at the time the invention was made.

Regarding claims 4, 23, and 42, the combination of Tadayon, Brody, Collins, and Sato teaches wherein the sending instructions further identify a digital rights management control to be applied to the file (Tadayon, paragraphs 17-30).

16. Claims 5-11, 13-19, 24-30, 32-38, 43-49, 51-57, and 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadayon, Brody, Collins, and Sato, and further in view of Stefik.

Regarding claims 5, 13, 24, 32, 43, 51, and 59, the combination of Tadayon, Brody, Collins, and Sato does not expressly disclose wherein the digital rights management control indicates that no copy may be made of the file from the second memory device. However, Stefik teaches wherein the digital rights management control indicates that no copy may be made of the file from the second memory device (column 21, lines 1-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to indicate that no copy may be made. One of ordinary skill in the art would have been motivated to do so because it was well known in the art to limit the number of copies a recipient may be able to make (Stefik, column 21, lines 1-67).

Regarding claims 6, 14, 25, 33, 44, 52, and 60, the combination of Tadayon, Brody, Collins, and Sato does not expressly disclose wherein the digital rights management control indicates that no more than a given number of copies may be made of the file from the specific type of memory device. However, Stefik teaches wherein the digital rights management control indicates that no more than a given number of copies may be made of the file from the specific type of memory device

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(column 21, lines 1-67). The motivation for combining is the same as that for claim 5 above.

Regarding claims 7, 15, 26, 34, 45, 53, and 61, the combination of Tadayon, Brody, Collins, and Sato does not expressly disclose wherein the digital rights management control indicates that no copy may be made of the file from the specific type of memory device if the number of outstanding copies already made of the file from the specific type of memory device is equal to a given number. However, Stefik teaches wherein the digital rights management control indicates that no copy may be made of the file from the specific type of memory device if the number of outstanding copies already made of the file from the specific type of memory device is equal to a given number (column 21, lines 1-67). The motivation for combining is the same as that for claim 5 above.

Regarding claims 8, 16, 27, 35, 46, 54, and 62, the combination of Tadayon, Brody, Collins, and Sato does not expressly disclose wherein the digital rights management control indicates a maximum number of times the copy can be used is equal to a given number. However, Stefik teaches wherein the digital rights management control indicates a maximum number of times the copy can be used is equal to a given number (column 21, lines 1-67). The motivation for combining is the same as that for claim 5 above.

Regarding claims 9, 17, 28, 36, 47, 55, and 63, the combination of Tadayon, Brody, Collins, and Sato does not expressly disclose wherein the digital rights management control indicates a fee amount to be charged to the recipient based upon

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the use of the copy stored at the specific type of memory device. However, Stefik teaches wherein the digital rights management control indicates a fee amount to be charged to the recipient based upon the use of the copy stored at the specific type of memory device (column 29, lines 1-67, column 30, lines 1-67). The motivation for combining is the same as that for claim 5 above.

Regarding claims 10, 18, 29, 37, 48, 56, and 64, the combination of Tadayon, Brody, Collins, and Sato does not expressly disclose wherein the digital rights management control indicates an amount to be credited to the recipient based upon the use of the copy stored at the specific type of memory device. However, Stefik teaches wherein the digital rights management control indicates an amount to be credited to the recipient based upon the use of the copy stored at the specific type of memory device (column 29, lines 1-67, column 30, lines 1-67). The motivation for combining is the same as that for claim 5 above.

Regarding claims 11, 19, 30, 38, 49, 57, and 65, the combination of Tadayon, Brody, Collins, and Sato does not expressly disclose wherein the digital rights management control indicates an amount to be credited to the recipient based upon the use of a copy derived from the copy of the file stored at the specific type of memory device. However, Stefik teaches wherein the digital rights management control indicates an amount to be credited to the recipient based upon the use of a copy derived from the copy of the file stored at the specific type of memory device (column 29, lines 1-67, column 30, lines 1-67). The motivation for combining is the same as that for claim 5 above.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hughes (US patent 6,748,537) teaches a system for controlling sue and duplication of digital contents on removable media.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone

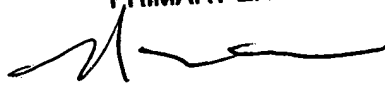
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number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

NASSER MOAZZAMI
PRIMARY EXAMINER


8,14,06